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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/581,050	12/27/1995	TAKAHISA UEDA		6204

7590 11/29/2001

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EXAMINER

DEPUMPO, DANIEL G

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 11/29/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
08/581,050

Applicant(s)

Ueda

Examiner

Daniel G. DePumpo

Art Unit

3611



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 9, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 14, and 16-31 is/are pending in the application.
- 4a) Of the above, claim(s) 1, 3-11, 13, 14, and 16-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Art Unit: 3611

1. Throughout the lengthy prosecution of this application, numerous office actions have been made final on first action. This is because applicant has chosen to file continuing applications instead of filing an After Final Amendment. Applicant is reminded that an application should be fully prosecuted before a continuing application is filed. If an After Final Amendment presents New Issues, this will be indicated in an Advisory Action. It is noted that the following office action could have been made final because the rejections are identical to rejections that have been repeated since at least April of 1997. Applicant is cautioned that future rejections will be made final on first action, when appropriate. This is likely if it has not been established, in an Advisory Action, that an amendment raises new issues.

2. In the amendment filed December 19, 2000, applicant presented claims 5 and 6 as "new claims". It is noted that the application previously contained claims 1-29. Consequently, claims 5 and 6 can not be new claims. These new claims have been renumbered as claims 30 and 31. In future communication, applicant should refer to these as claims 30 and 31.

Also, a cursory review of the non-elected claims shows that these claims have not been amended consistently. For example, it is noted that claim 3, as presented in the amendment filed July 5, 2000 does not correspond to the claim 3 of record prior to the July 5, 2000 amendment. Claim 3, as presented in the July 5, 2000 amendment is a dependent claim, while the previous claim 3 of record is an independent claim. Also, claim 4, as presented in the July 5, 2000 amendment does not correspond to the claim 4 of record prior to the July 5, 2000 amendment. Clarification and/or correction is required.

Art Unit: 3611

It is noted that some of these observations were presented in the restriction requirement (paper 39, August 9, 2001), however, they were not addressed in the applicant's subsequent response. Applicant is cautioned that future communication that does not address these issues will be considered non-responsive.

3. Applicant's election without traverse of the packing claims (Group I) and the specie of fig. 3 (species B) in Paper No. 41 is acknowledged. Applicant did not indicate which claims read on the elected species. However, in paper number 5, filed May 8, 1995, applicant indicated that claim 2 reads on this species.

4. Claims 1, 3-11, 13, 14 and 16-31 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The recitation that the fiber yarns are "coated with adhesive" is not supported by the originally filed specification.

Art Unit: 3611

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, it is unclear what "with said adhesive" refers to.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda et al. '030 in view of Ogino et al.

See the rejection of paper number 17. In Ueda, it is noted that since the narrow fibers are laminated with the graphite, the graphite surrounds the fibers. Also, fig. 8 clearly shows that the graphite surrounds the fibers.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Case et al. in view of Schnitzler.

See the rejection of paper number 17.

Art Unit: 3611

12. Applicant's arguments filed December 19, 2000 have been fully considered but they are not persuasive.

In the Remarks, applicant refers to the final rejection dated August 29, 2000 (Paper No. 28). It is noted that this is not the most recent rejection. Instead, the most recent rejection is dated December 14, 2000 (Paper No. 31).

In the second paragraph of the Remarks, applicant states that certain references were "applied against claims 2 as four times amended and claims 3-4". To the contrary, claims 3 and 4 have been withdrawn from consideration throughout prosecution of this application.

Applicant asserts that Ueda et al. '030, Ogino et al. and Schnitzler require that the expanded graphite particles be made into sheets. Applicant then points out that the instant invention does not use sheets. This may be correct, however, the claim language only requires that the expanded graphite surrounds the fiber yarns. Clearly, the graphite sheets of the prior art surround the fiber yarns. This is clearly shown in at least figs. 7 and 8 of Ueda '030.


Enclosures A and B are noted, however, the claim language does not define over the applied references.

At the top of page 4, applicant refers to "independent 4". It is unclear, but this is apparently intended to refer to *dependent claim 4*. However, claim 4 is non-elected.

It is noted that the rejection based on Case et al. has not been addressed.

Art Unit: 3611

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel G. DePumpo whose telephone number is (703) 308-1113.



**DANIEL G. DePUMPO**  
**PRIMARY EXAMINER**

dgd

November 27, 2001